

R E M A R K S

After careful consideration of the outstanding Office Action, this application has been amended accordingly, and favorable reconsideration and allowance of the claims or record is herewith respectfully requested.

The Examiner has rejected independent claims 10 and 28 at page 2. paragraph 2 of the outstanding Office Action "under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,210,975 to Beckerman." The Examiner specifically referred to Figures 1 through 9 of the Beckerman patent and identified the major and minor opposing surface area portions as being "the major - at 14 and minor - at 12." The first and second paper sheets are bonded to each other, just as the Examiner explained, but the bonding is strictly peripheral bonding in order that a germinated seed 16 can be housed and confined between the minor opposing surface area portions, at least temporarily, while **soil 18 is housed between the major opposing surface area portions 14.** Between the minor 12 and major 14 opposing surface area portions, there is a "divider seal 36" which is positioned "a predetermined distance 38 from the side seal 34 so that when the first package 12 is transformed into the sprouter pocket, the sprouter pocket has a particular volume capacity **for holding substantially all of the soil 18 contained in the second package 18.**" (See column 3, line 60-65.) More specifically, the width 39 of the divider seal 36 "enables the first package 12 to retain a portion of the divider seal 36 when the first package 12 is cut or otherwise severed from the second package 14, so that the former may remain sealed for forming the sprouter pocket." (See paragraph bridging columns 3 and 4.)

The latter is depicted in Figure 4 with the pocket of the minor opposing surface area portions 12 containing the seeds as shown being opened in Figure 5. Thereafter, the packet is "filled with the soil 18" which causes the sprouter pocket 40 to expand which accommodates any roots that are to be "sprouted from the seed 16." (See column 5, lines 1-27.) The latter appears to reflect the scope and content of the Beckerman patent when validly interpreted by a person skilled in the art. The latter does not support the Examiner's statement appearing at the top of page 3, beginning at line 4 of the outstanding Office Action, that "the minor opposing surface area portions and the confined germinative seed housed therein can be entirely bodily removed as a plantable unit from the major opposing surface area portions along the lines of perforations for subsequent planting absent adversely affecting, damaging or destroying the major opposing surface area portions." The factual situation is that there is no "plantable **unit**" defined by minor opposing surface area portions and a germinative seed that is in fact planted or intended for planting. Instead, **soil** from between the major opposing surface area portions is **removed** and is **inserted** into what is clearly "the sprouter pocket 40," In other words, soil is removed from the major pocket and is inserted in the minor pocket and the minor pocket is indeed **not a "plantable unit."** As was stated in Stoller v. Ford Motor Co., 18 USPQ 2d 1545, 1546 "A prior art reference anticipates a claim, and thus invalidates it under 35 U.S.C. § 102, if that reference discloses each and every element of the claim." Each and every element of claims 10 and 28 is not disclosed in the Beckerman patent.

In order to avoid any question as to the scope and content of independent claims 10 and 28 and/or the teaching "as a whole" of the patent

to Beckerman, the undersigned has amended independent claims 10 and 28 substantially identically. In each of the latter claims, the major opposing surface area portions are recited not only as being "devoid of germination seeds therebetween" but added thereto is the language – "including **only** adhesive therebetween." In other words, the latter language excludes anything other than adhesive between the major opposing surface area portions, whereas in the Beckerman patent included in the major pocket or between the major opposing surface area portions is "soil 18."

Interestingly enough, the Examiner makes no mention in his description of the Beckerman patent in the outstanding Office Action in the paragraph bridging pages 2 and 3 of the soil 18 between the major opposing surface area portions. By limiting claims 10 and 28 in the manner stated, the undersigned has not only distinguished the present invention over the Beckerman patent but has specified language which not only avoids anticipation but also avoids obviousness under 35 U.S.C. § 103(b) because a person skilled in the art would not be motivated to exclude the soil 18 which necessarily must be included as part of the Beckerman invention to render the same operative. Quite clearly, absent the soil 18, the seeds 16 in the sprouter pocket could not germinate and, thus, the entire intent of the seed-sprouting kit of Beckerman would be destroyed. Accordingly, as now amended, independent claims 10 and 28 are neither anticipated (35 U.S.C. § 102(b)) nor rendered obvious (35 U.S.C. § 103(a)) by the Beckerman patent. Accordingly, the formal allowance of the latter independent claims and each of the claims depending therefrom is considered proper and is herewith respectfully requested.

One further comment is considered appropriate with respect to the Examiner's statement concerning "functional language" which allegedly has "no bearing on the patentability of the claims." The decision cited by the Examiner appears in Section 2114 of the MPEP which also includes the following sentence:

Even if the prior art device performs all of the functions recited in the claim, the prior art cannot anticipate the claim if there is **any** structural difference.

Suffice it to say that there are several structural differences recited in claims 10 and 28, as aforesaid, and thus the Examiner cannot merely cast aside "functional language" as allegedly having "no bearing on the patentability of the claims." Quite to the contrary, the Examiner must clearly resolve the issue of obviousness from both the standpoint of structural limitations and the manner in which the latter attain the functional limitations characterized thereby. Significantly, the patent to Beckerman unequivocally does not disclose a "plantable unit" which is defined by a minor portion containing a germinative seed which is planted as a unit. Accordingly, since the Beckerman patent lacks the capability of anticipating or rendering obvious claims 10 and 28, the formal allowance of all of the claims of record followed by the passage of this application to issue at an early date would be most appreciated.

Though the Examiner has also rejected several of the claims based upon 35 U.S.C. § 103, each rejection is untenable because each rejection is based upon Beckerman "as applied to claims 10 and 16 above" or "as applied to claim 10 above" or "as applied to claim 28 above," the latter-

quoted rejections being based upon 35 U.S.C. § 102(b). Having applied the patent to Beckerman against claims 10 and 28 under Section 102(b), the Examiner cannot properly extrapolate, extend or expand the Section 102(b) rejections under 35 U.S.C. §103(a) because of the different legal standards applied to each individual statutory rejection. However, irrespective of the Examiner's intent in these rejections, each of independent claims 10 and 28 are directed to unobvious subject matter, as noted earlier, thereby indicating obviousness under 35 U.S.C. § 103(a) irrespective of the secondarily applied patents.

At page 8 of the outstanding Office Action, the Examiner has made several brief comments concerning three patents which the undersigned acknowledges to be broad but relatively accurate. The undersigned will add thereto that planting bags and planting pots which define the subject matter of these three patents have absolutely nothing to do with the present invention, as disclosed and claimed herein. These patents are not merely cumulative, they are immaterial to the present disclosure.

In view of the foregoing, the formal allowance of this application at an early date is herewith again respectfully solicited.

Respectfully submitted,

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